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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,536	01/12/2001	Carl Teo Balbach	31215.new	1174

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EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,536

Applicant(s)

BALBACH, CARL TEO

Examiner

Jonathan Ouellette

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,12-14,16,20,27-30,41 and 44 is/are rejected.
- 7) ☒ Claim(s) 2-4,6-11,15,17-19,21-26,31-40,42,43 and 45-47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 11/8/2003 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/759,536 is acceptable and a RCE has been established. An action on the RCE follows.

Claim Objections

2. Claims 2-4, 6-11, 15, 17-19, 21-26, 31-40, 42-43, 45-47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 16, and 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

5. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".
6. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

7. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

8. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.
9. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found

that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

10. Independent Claims 1, 16, and 44 appear to be describing a method that is attempting to sell a contact information, wherein document information is manually matched with contact information and provided to the user. Thus, this process does not include a distinguishable apparatus, computer implementation, or any other incorporated technology, and would appear to be an attempt to patent an abstract idea not a "tangible" process and, therefore, non-statutory subject matter.

11. Mere intended or nominal use of a component (network, database), albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 13. Claims 1, 16, 30, 41, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedloy et al. (US 6,323,853 B1).**

14. As per independent Claims 1, 16, 30, and 41, Hedloy discloses a method (article of manufacture, system) of selecting contact information, comprising: analyzing a document to determine a referenced entity identified in the document (Abstract); providing a data base of contact entities (Fig.1b), the data base having information corresponding to a plurality of contact entities; determining whether the referenced entity is among the contact entities; and if the referenced entity is among the contact entities, then selecting the contact information corresponding to the referenced entity (Abstract, Fig.1b, C10 L5-9).

15. Hedloy fails to expressly disclose analyzing an electronic source document available on a network of computers.

16. However, Hedloy does disclose using the contact information management/search system with electronic documents (C9 L50-64), and it would have been obvious to use the system with an electronic source document available on a network of computers, as such documents were well known at the time the invention was made and easily integrated with the database search system described by Hedloy.
17. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an electronic source document available on a network of computers, in the system disclosed by Hedloy, for the advantage of providing a method of selecting contact information, with the ability to increase effectiveness of the system by providing the user with a multitude of documents/document formats to search for contact information.
18. Hedloy also fails to expressly disclose providing criteria that a message must satisfy in order to be accepted to the referenced entity.
19. However, official notice is given that electronic mail filter/criteria systems were well known at the time of the invention was made, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide listing message criteria to a user.
20. **As per independent Claim 44**, Hedloy discloses a method of providing a sender with contact information, comprising: analyzing a document to determine a plurality of referenced entities identified in the document (Abstract); providing a data base of contact entities (Fig.1b), the data base having information corresponding to a plurality of contact entities; determining whether the referenced entities are among the contact entities;

providing a list of referenced entities [information items] that are among the contact entities [selected referenced entity]; selecting from the list of referenced entities one of the referenced entities; selecting the contact information corresponding to the selected referenced entity (automation is inherent to the system disclosed by Iinuma); and providing to the sender the selected contact information (Abstract, Fig.1b, C7 L16-62, C10 L5-9).

21. Hedloy fails to expressly disclose analyzing an electronic source document available on a network of computers.
22. However, Hedloy does disclose using the contact information management/search system with electronic documents (C9 L50-64), and it would have been obvious to use the system with an electronic source document available on a network of computers, as such documents were well known at the time the invention was made and easily integrated with the database search system described by Hedloy.
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an electronic source document available on a network of computers, in the system disclosed by Hedloy, for the advantage of providing a method of selecting contact information, with the ability to increase effectiveness of the system by providing the user with a multitude of documents/document formats to search for contact information.
24. Hedloy also fails to expressly disclose providing criteria that a message must satisfy in order to be accepted to the referenced entity.

25. However, official notice is given that electronic mail filter/criteria systems were well known at the time of the invention was made, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide listing message criteria to a user.

26. Claims 5, 12-14, 20, and 27-29 are rejected under 35 U.S.C. 103 as being unpatentable over Hedloy.

27. As per Claims 5 and 20, Hedloy does not expressly show wherein analyzing the message to determine whether the message satisfies criteria specified by the referenced entity includes determining whether the message has obscenities therein.

28. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of message criteria used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined whether the message satisfied the criteria specified by the referenced entity, which included determining whether the message had obscenities therein, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

30. As per Claims 12-14 and 27-29, Hedloy does not expressly show wherein the contact information includes a postal address, Internet address, or phone number.
31. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of contact information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
32. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a postal address, Internet address, or phone number as contact information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Allowable Subject Matter

33. **Claims 2-4, 6-11, 15, 17-19, 21-26, 31-40, 42-43, and 45-47**, contain allowable subject matter.
34. The following is a statement of reasons for the indication of allowable subject matter:
35. Claims 2, 17, 31, and 42 disclose prompting a sender to provide a message to the referenced entity.
36. Claims 3, 18, and 32 disclose receiving the message from the sender.

37. Claims 4, 19, 33, and 43 disclose analyzing the message to determine whether the message satisfies the criteria.
38. Claims 6, 21, and 34 disclose providing the message to the referenced entity.
39. Claims 7, 22, and 35 disclose prompting the sender to provide a preferred method of delivering the message.
40. Claims 8, 23, and 36 disclose wherein the preferred method may be provided by selecting from a group consisting of e-mail and postal address.
41. Claims 9, 24, and 37 disclose prompting the sender to provide information required by the referenced entity.
42. Claims 10, 25, and 38 disclose providing to the sender conditions that the sender must satisfy prior to sending the message.
43. Claims 11, 26, and 39 disclose prompting the sender to provide information; and using the information provided by the sender to categorize the message.
44. Claims 15 and 40 disclose determining a key word in the source document that is associates with the referenced entity; and prioritizing selected contact information corresponding to the referenced entity by giving a high priority to contact information associated with the keyword.
45. Claim 45 discloses providing counters, each counter being capable of providing a cumulative total, and each counter being associated with one of the referenced entities; incrementing one of the counters when the associates referenced entity is selected; prioritizing the list of referenced entities by the cumulative totals provided by the counters.

46. Claim 46 discloses providing a list of contact information items corresponding to the selected referenced entity; selecting from the list of contact information items one or the contact information items; and providing the selected contact information item to the sender.
47. Claim 47 discloses providing counters, each counter being capable of providing a cumulative total, and each counter being associated with one of the selected contact information items; incrementing one of the counters when the associated contact information item is selected; prioritizing the list of contact information items by the cumulative totals provided by the counters.
48. The prior art of Hedloy teaches a method/system of matching/selecting contact information (as described in the rejection above).
49. However, Hedloy fails to teach or suggest the automated facilitation of a structured communication between the user and the intended contact (referenced entity).
50. The following independent Claim 1 (language to be integrated into independent claims 16, 30, 41, and 44) drafted by the examiner and considered to distinguish patentably over the art of record in this application, is presented to applicant for consideration: A method of selecting contact information, comprising: automatically analyzing a document to determine a referenced entity identified in the document; automatically providing a data base of contact entities, the data base having information corresponding to a plurality of contact entities; automatically determining whether the referenced entity is among the contact entities; and if the referenced entity is among the contact entities, then selecting the contact information corresponding to the referenced entity; providing to the sender

the selected contact information and criteria that a message must satisfy in order to be acceptable to the referenced entity; and prompting the sender to provide a message to the referenced entity .

Response to Arguments

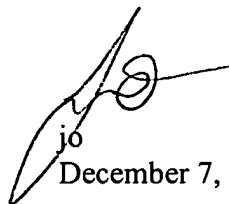
51. Applicant's arguments filed 11/8/04, with respect to Claims 1-47, have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

52. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

53. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

54. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.


jo
December 7, 2004


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600